

Appl. No. 10/768,508

Amdt. dated Feb. 18, 2005

Reply to Office action dated November 18, 2005

**REMARKS/ARGUMENTS**

Claims 1-8 remain pending in the application. Reexamination and reconsideration of the claims are respectfully requested.

**CLAIM OBJECTIONS**

The Examiner objects to claims 1, 5, 6, 7 and 8. Claims 1, 5, 6, 7 and 8 have been amended and the Applicant thanks the Examiner for the suggested changes to put these claims in form for allowance.

**REJECTIONS UNDER 35 U.S.C. § 102(b) / § 103(a)**

The Examiner rejects claims 1-8 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Freestone (US Patent 5,917,129 published 29 June 1999).

The Examiner states that the plant of the instant application and 93B51 have several traits in common. However, the Applicant would like to point out key differences between XB32Y04 and 93B51.

XB32Y04 is a low linolenic soybean variety while 93B51 is not a low linolenic variety. Also, XB32Y04 and 93B51 differ in maturity and geographical adaptation. XB32Y04 has a maturity group of 32. 93B51 has a maturity group of 35. Therefore, these two lines are not identical.

The Examiner has stated that if the claimed plant and seeds of the instant invention are not identical to 93B51, then it appears that 93B51 only differs from the claimed plants and seeds due to minor morphological variation wherein said variation would not confer a patentable distinction to XB32Y04 plants. Applicant respectfully traverses. XB32Y04, as stated on page 12 of the specification, has a modified fatty acid profile to fit low linolenic acid applications. The low linolenic acid soybean market is a different market than the commodity soybean market, and soybean varieties with this fatty acid profile are often produced for specific end-use products. A press release states that XB32Y04 (commercially known as 93M20) is "the first commercially available low linolenic soybean product variety with yield and weed

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control options that are competitive with the best soybean varieties on the market" (See Appendix A). In contrast, 93B51 is a commodity soybean variety, and does not contain the modified fatty acid profile exhibited in XB32Y04 for the low linolenic market.

These differences show that the variation between XB32Y04 and 93B51 is more than minor morphological variation.

In light of the above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to claims 1-8 under 35 U.S.C. 102(b) and 103(a).

#### REJECTION UNDER DOUBLE PATENTING

The Examiner has rejected claims 1-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,917,129.

The Examiner states that the plant of the instant application and 93B51 have several traits in common. However, the Applicant would like to point out several key differences between XB32Y04 and 93B51.

XB32Y04 is a low linolenic soybean variety while 93B51 is not a low linolenic variety. Also, XB32Y04 and 93B51 differ in maturity and geographical adaptation. XB32Y04 has a maturity group of 32. 93B51 has a maturity group of 35. Therefore, these two lines are not identical.

The Examiner has stated that if the claimed plant and seeds of the instant invention are not identical to 93B51, then it appears that 93B51 only differs from the claimed plants and seeds due to minor morphological variation wherein said variation would not confer a patentable distinction to XB32Y04 plants. Applicant respectfully traverses. XB32Y04, as stated on page 12 of the specification, has a modified fatty acid profile to fit low linolenic acid applications. The low linolenic acid soybean market is a different market than the commodity soybean market, and soybean varieties with this fatty acid profile are often produced for specific end-use products. A press release states that XB32Y04 (commercially known as 93M20) is "the first

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commercially available low linolenic soybean product variety with yield and weed control options that are competitive with the best soybean varieties on the market." (See Appendix A). In contrast, 93B51 is a commodity soybean variety, and does not contain the modified fatty acid profile exhibited in XB32Y04 for the low linolenic market.

Therefore, not only does XB32Y04 differ from 93B51, XB32Y04 exhibits a characteristic not exhibited in 93B51.

In light of the above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to claims 1-8 under the judicially created doctrine of obviousness-type double patenting.

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## CONCLUSION

Applicant submits that in light of the foregoing amendments and remarks, the claims as amended are in condition for allowance. No new matter has been added. Reconsideration is respectfully requested. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

Respectfully submitted,  
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